

REMARKS

In the Office Action¹ mailed April 11, 2008, the Examiner:

rejected claims 72-78 and 85 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 6,475,369 to Cohen ("Cohen");

rejected claims 81-84, 93, 94, and 96 under 35 U.S.C. § 103(a) as allegedly obvious over Cohen;

rejected claims 79 and 80 under 35 U.S.C. § 103(a) as allegedly obvious over Cohen in view of U.S. Patent No. 3,190,822 to Burnham ("Burnham");

rejected claims 86-89 under 35 U.S.C. § 103(a) as allegedly obvious over Cohen in view of U.S. Patent No. 6,036,833 to Tang et al. ("Tang");

rejected claims 90, 91, and 95 under 35 U.S.C. § 103(a) as allegedly obvious over Cohen in view of U.S. Patent No. 5,196,109 to Scott ("Scott"); and

rejected claim 92 under 35 U.S.C. § 103(a) as allegedly obvious over Cohen in view of U.S. Patent No. 4,932,518 to Bernards et al. ("Bernards").

Claims 72-96 are pending.

Applicant respectfully traverses the rejection of claims 72-78 and 85 under 35 U.S.C. § 102(b) as anticipated by Cohen.

In order to properly establish that Cohen anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Cohen does not anticipate the claims at least because it fails to teach each and every element of the claims.

Claim 72 recites, among other elements, “patterning the substrate by an electrochemical transfer process, wherein material is dissolved at an anode and deposited at a cathode, and an electrolyte solution is used as a transport medium, wherein. . . the dissolved material is an anode material, which is pre-deposited in the at least one cavity defined in the master electrode” (emphasis added). Cohen does not teach, or even suggest, at least this element of claim 72.

The Office Action alleges that “the electrically conductive surface of the substrate is the cathode and the dissolved material is an anode material, which is pre-deposited (i.e., erodable metal layer supported by a conductive material such as platinized titanium, column 7 lines 49-52) in the at least one cavity defined in the master electrode. The erodable metal layer is inherently pre-deposited on the conductive material since it is a different material tha[n] the conductive material.” Office Action at page 3-4.

The Office Action does not rely on express description, but only on the principles of inherency to reject this feature of claim 72. MPEP § 2131 IV states “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.’” To show inherency, the Office Action implies that since a conductive material, for example platinized titanium, is disclosed to “support” an erodable layer, the conductive material must necessarily have

been deposited before the erodable layer because the conductive material is different from the erodable metal layer. This construction of the Cohen disclosure, as applied to claim 72, is incorrect. It is not necessarily true that the conductive material is deposited before the erodable layer. The Office Action has not shown as a basis in fact, or any technical reasoning showing that merely because a conductive material “supports” the erodable layer that the conductive material must be deposited before the erodable layer. Thus, the Examiner has not demonstrated that the claimed “pre-deposited” feature is disclosed by Cohen.

Moreover, such a disclosure does not constitute the claimed “the dissolved material is an anode material, which is pre-deposited in the at least one cavity defined in the master electrode.” Cohen discloses “[t]he anode can be soluble or insoluble, rigid or flexible, porous or nonporous, and can include an erodable layer (e.g., a metal layer) supported by a conductive material that does not erode (e.g., platinized titanium).” Cohen column 7 lines 49-52. Cohen fails to disclose or even suggest that the conductive material, e.g., platinized titanium, is “pre-deposited in the at least one cavity defined by the master electrode.” Cohen merely describes that an erodable layer is deposited on top of of a supportive conductive material stating “[t]he anode can be of any dimension including a thin flexible sheet of metal.” Cohen column 7 lines 52-53. A “thin flexible sheet of metal” must sit on supports, not between supports in a cavity as the Office Action alleges.

Even assuming Cohen did disclose at least one cavity created between supports in the supportive conductive material, which Cohen does not disclose and Applicant does not concede, Cohen fails to disclose that the erodable layer is “pre-

deposited in the at least one cavity defined by the master electrode.” Cohen’s “erodable layer,” assuming a cavity exists, sits on the supports, and does not extend to the space in the cavity between supports. Thus, Cohen fails to disclose each and every feature of claim 72.

For the reasons stated above, Cohen fails to teach or suggest each and every element recited in independent claim 72. Claims 72-78 and 85 are allowable over Cohen at least because of their dependence from one of claim 72.

Applicant respectfully traverses the rejection of claims 79-84 and 86-96 under 35 U.S.C. §103(a) as unpatentable over combinations of Cohen, Burnham, Tang, Scott, and Bernards. Each of Burnham, Tang, Scott, and Bernards and Official Notice fails to remedy the deficiencies of Cohen as discussed above.

Notwithstanding the above, the Examiner further relies on Official Notice. With regard to dependent claims 81-84, 93, 94 and 96, Applicant requests that the Examiner provide documentary evidence to support each assertion of Official Notice. Absent documentary evidence, the Office Action has failed to make a *prima facie* case of obviousness regarding dependent claims 81-84, 93, 94 and 96.

Therefore, claims 79-84 and 86-96 are allowable over the prior art at least due to their dependencies on allowable independent claims 72. Applicant respectfully requests the Examiner withdraw the rejection of claims 79-84 and 86-96 under 35 U.S.C. §103(a) and allow these claims.

CONCLUSION

In view of the foregoing, the pending claims are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the Examiner's reconsideration of the application, and the timely allowance of the pending claims.


If a telephone interview will expedite issuance of this application, the Examiner is requested to call Applicant's representative whose name and registration number appear below at (202) 408-4214, to discuss any remaining issues.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: July 9, 2008

By: 
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